

## REMARKS

### A. Background

Claims 8-23 were pending in the application at the time of the Office Action. All of the pending claims were rejected as being obvious over cited art. By this response applicant has amended claims 8, 12, 20, and 22 to clarify the claims. As such, claims 8-23 are presented for the Examiner's consideration in light of the following remarks.

### B. Claim Rejections based on 35 U.S.C. 103

#### 1. Rejections based on *Eldering I*, *Eldering II*, *Eldering III*, and *Hermann*

Paragraphs 3 and 4 of the Office Action reject claims 8, 10, 12, 13, and 17-21 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0148625 to Eldering et al. ("*Eldering I*") in view of U.S. Patent Application Publications No. 2005/0193410 to Eldering ("*Eldering II*"), 2002/0083443 to Eldering et al. ("*Eldering III*") and Hermann et al. ("*Hermann*"). Paragraph 10 of the Office Action reject claims 22 and 23 under 35 U.S.C. 103(a) as being unpatentable over *Eldering I* in view of *Eldering II*. Applicant respectfully traverses these rejections. Of the rejected claims, claim 8, 20, and 22 are the independent claims.

The Office Action asserts that *Eldering I* discloses some of the features of the rejected independent claims, but concedes that *Eldering I* does not disclose many of the claim limitations. For example, the Office Action concedes that *Eldering I* does not teach the following limitations and alleges that the limitations are taught in *Eldering II*:

- Interrogating the subscriber with an individual IP address;
- Means for broadcasting advertisements that transmits multiple advertisements to a target IP address for the same advertisement slot.

Applicant respectfully disagrees with the Office Action and submits that the above limitations are not taught or suggested by *Eldering II*.

Applicant submits that *Eldering II* does not explicitly state that an individual IP address is "interrogated," contrary to the assertion of the Office Action. The portions of *Eldering I* to which the Office Action refers (page 3, paragraph 36, and page 6, paragraph 74) merely specify that profiles can be grouped in terms of IP addresses. This is not the same thing as interrogating the set top boxes using the individual IP addresses, as set forth in claim 8. Furthermore, there is

nothing in the portions of *Eldering II* identified by the Examiner that suggest that audience profiles are even obtained from set-top boxes. Instead, it appears that they are obtained from separate databases which have previously gathered such information.

In addition, while *Eldering II* may disclose the receipt of multiple ads, it does not explicitly state that the multiple ads are for the same advertisement slot in the same target IP address as required by claims 8, 20, and 22. *Eldering II* suggests that a plurality of advertisements may be provided for use in any slot in various different IP addresses. The device or set-top box can then decide which of these ads to display during particular slots. There is nothing in *Eldering II* that states or infers that the ads are for the same slot.

While paragraph 45 of *Eldering II* discusses the possibility of having a plurality of subscribers using a single set-top box to watch different advertisements, *Eldering II* clearly identifies this as a future possibility; the paragraph begins with “In the future, ...” Thus, these features are simply the author’s vision of a possible future and cannot be used as already disclosing such a device. These features cannot be used to invalidate the claimed invention in the same manner that Gene Roddenberry’s vision of a transporter on Star Trek cannot be used to invalidate a future patent directed to a similar transporter device. Other than the possible future discussed in paragraph 45, *Eldering II* only discloses that different advertisements are sent to different subgroups, with each subgroup representing a different single IP address. While *Eldering II* discloses sending multiple presentation streams, each receiver only receives a single one of those presentation streams (see paragraph 51). That is, in *Eldering II*, each receiver receives a single, complete presentation string including advertisements directed to that receiver (see paragraph 10). Contrary to the assertion of the Office Action, this is not the same thing as sending multiple advertisements to the same target ip address (i.e. receiver) for the same advertisement slot. Applicant notes that *Eldering III* and *Hermann* also do not cure the above deficiencies of *Eldering I*.

In light of the above, Applicant respectfully submits that a *prima facie* case of obviousness has not been established regarding independent claims 8, 20, and 22 at least because the cited references, taken together or individually, fail to disclose all of the limitations of the rejected claims. Specifically, the cited references all fail to disclose a “means for interrogating set top boxes with individual IP addresses,” or “means for broadcasting advertisements [that] transmits multiple advertisements to a same target IP address for the same advertisement slot,” as

recited in amended claims 8 and 20. Accordingly, Applicant respectfully requests that the obviousness rejection with respect to claims 8 and 20 be withdrawn.

Claims 10, 12, 13, 17-19, 21, and 23 depend from claims 8, 20, and 22 and thus incorporate the limitations thereof. As such, applicant submits that claims 10, 12, 13, 17-19, 21, and 23 are distinguished over the cited art for at least the same reasons as discussed above with regard to claims 8, 20, and 22. Accordingly, Applicant respectfully requests that the obviousness rejection with respect to claims 10, 12, 13, 17-19, 21, and 23 also be withdrawn.

## 2. Rejections based on further cited art

Paragraphs 5-9 of the Office Action reject claims 9, 11, and 14-16 under 35 U.S.C. 103(a) as being unpatentable over the allegedly obvious combination of *Eldering I*, *Eldering II*, *Eldering II*, and *Hermann*, and further in view of various other U.S. Patent Publications. Specifically, claim 9 is rejected in view of U.S. Patent No. 6,286,140 to Ivanyi (“*Ivanyi*”); claim 11 is rejected in view of U.S. Patent Application Publication No. 2002/0124253 to Eyer (“*Eyer*”); claim 14 is rejected in view of U.S. Patent No. 6,698,020 to Zigmond (“*Zigmond*”); claim 15 is rejected in view of U.S. Patent Application Publication No. 2002/0038455 to Srinivasan et al. (“*Srinivasan*”); and claim 16 is rejected in view of *Zigmond* and U.S. Patent Application Publication No. 2004/0111741 to DePietro (“*DePietro*”).

Claims 9, 11, and 14-16 all depend from claim 8 and thus incorporate all of the limitations thereof. *Ivanyi*, *Eyer*, *Eldering III*, *Zigmond*, *Srinivasan*, and *DePietro* are all merely cited for allegedly teaching various further limitations recited in the respective dependent claims. Applicant submits that those references all fail to cure the deficiencies of *Eldering I* and *Eldering II*, discussed above. That is, none of *Ivanyi*, *Eyer*, *Eldering III*, *Zigmond*, *Srinivasan*, and *DePietro* disclose or suggest interrogating set top boxes with individual IP addresses and transmitting multiple advertisements to a same target IP address for the same advertisement slot. As such, Applicant submits that a *prima facie* case of obviousness has not been established regarding claims 9, 11, 12, and 14-16 for at least the same reasons discussed above regarding claim 8. Accordingly, Applicant respectfully requests that the obviousness rejection with respect to claims 9, 11, 12, and 14-16 be withdrawn.

C. Objection based on Double Patenting

Paragraph 11 of the Office Action advises that should claim 8 be found to be allowable, the Examiner will object to claim 20 as being a substantial duplicate thereof. Applicant acknowledges the potential future objection and will address the objection once either claim 8 or claim 20 is found to be allowable. Applicant notes that deferring any discussion of the potential future objection does not indicate any admission by the Applicant, implicit or otherwise, concerning the merits of the objection.

No other objections or rejections are set forth in the Office Action.

D. Conclusion

Applicant notes that this response does not discuss every reason why the claims of the present application are distinguished over the cited art. Most notably, applicant submits that many if not all of the dependent claims are independently distinguishable over the cited art. Applicant has merely submitted those arguments which it considers sufficient to clearly distinguish the claims over the cited art.

In view of the foregoing, applicant respectfully requests the Examiner's reconsideration and allowance of claims 8-23 as amended and presented herein.

The Commissioner is hereby authorized to charge payment of any of the following fees that may be applicable to this communication, or credit any overpayment, to Deposit Account No. 23-3178: (1) any filing fees required under 37 CFR § 1.16; (2) any patent application and reexamination processing fees under 37 CFR § 1.17; and/or (3) any post issuance fees under 37 CFR § 1.20. In addition, if any additional extension of time is required, which has not otherwise been requested, please consider this a petition therefor and charge any additional fees that may be required to Deposit Account No. 23-3178.

In the event there remains any impediment to allowance of the claims which could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate such an interview with the undersigned.

Dated this 9th day of September 2010.

Respectfully submitted,

/Scott A. Woodbury/ Reg. #55743

SCOTT A. WOODBURY

Registration 55,743

DANA L. TANGREN

Registration No. 37,246

Attorneys for Applicant

Customer No. 022913

Telephone No. 801.533.9800

SAW:cad

2253633\_1